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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 10/791,211 | 03/02/2004 | Thomas E. Becker | HES 2002-IP-008430U1 | 1986 |

28857 7590 09/13/2006

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EXAMINER

BOMAR, THOMAS S

ART UNIT PAPER NUMBER

3672

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|--------------------------------------|--------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/791,211 | Applicant(s) BECKER ET AL. | |
| | Examiner Shane Bomar | Art Unit 3672 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☒ Applicant's reply has overcome the following rejection(s): the 35 USC 103(a) rejection of claims 9, 10, and 23-28.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: 9, 10 and 23-28.
 Claim(s) objected to: _____
 Claim(s) rejected: 1-6, 8, 11 and 12.
 Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____


Jennifer H. Gay
 Primary Examiner

Continuation of 11. does NOT place the application in condition for allowance because: The Applicant argues that Morris (3,417,816) and Brothers (5,135,577) are not combinable for a 35 USC 103(a) rejection because a) Morris teaches that the setting of a resin-containing or non-cementitious composition can be accelerated by irradiating the composition with gamma radiation and therefore one of ordinary skill in the art would only use this irradiation method to accelerate the setting thereof, and b) that Brothers teaches away from a method of placing a heating tool into casing containing Brothers' composition to accelerate the heating of the composition. I respectfully do not concur with these statements because a) the non-cementitious composition of Morris is merely an additional embodiment and not the embodiment I was relying on because I was using the composition of Brothers to replace the cementitious composition of Morris (although it must be noted that the phrase "can be accelerated" in Morris does not preclude heating and is only a suggestion), and b) the composition of Brothers that contains cement and latex, which sets by heat, was simply used as an alternative composition to that disclosed by Morris because Brothers' composition provides additional benefits over Morris, such as not allowing the solid particles of the cement to settle before setting (see col. 1, lines 42-50). It must be further noted that only the latex portion of the composition taught by Brothers is heated by the formation temperatures to allow the latex to gel, whereas the remaining cementitious portion would benefit from the heating tool taught by Morris to accelerate the setting thereof. Additionally, it would have been obvious to one of ordinary skill in the art that if the combined teachings of Morris and Brothers (i.e., Brothers' sealing composition surrounding Morris' casing and heating tool) were to be placed in a wellbore where the downhole temperatures were insufficient to gel the latex, then the heating tool would provide the necessary heat.